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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/749,069	12/27/2000	Takashi Shigetomi	8694.69US01	5650

23552 7590 05/07/2004

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EXAMINER	
CAMPBELL, JOSHUA D	
ART UNIT	**PAPER NUMBER**
2178	7

DATE MAILED: 05/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No	Applicant(s)	
	09/749,069	SHIGETOMI ET AL.	
	Examiner	Art Unit	
	Joshua D Campbell	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *27 December 2000*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *27 December 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: Application filed on 12/27/2000 and Priority Papers filed on 4/27/2001.

2. Claims 1-19 are pending in this case. Claims 1, 9, and 13 are independent claims.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

4. The drawings were received on 12/27/2000. The drawings are accepted.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Regarding claims 1, 9, and 13 the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

7. Regarding claims 1, 2, 9, 10, 13, and 14, because of the use of the phrase "and/or" throughout the claims it is noted that the specification must support the use of

each and every element separately and each and every combination of the elements. Claims 2, 10, and 14 do not allow for this type of analysis, because claims 2, 10, and 14 are dependent on one of the limitations in the "and/or" structure of claim 1, 9, and 13 and not all of the limitations separately and together in every possible combination. Therefore, claims 2, 10, and 14 are not examinable under all possible definitions of claims 1, 9, and 13.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brandt et al. (hereinafter Brandt, US Patent Number 6,646,655, filed on March 9, 1999).

Regarding independent claim 1 and dependent claim 2, Brandt discloses a method in which thumbnail images are displayed and based on the selection of those images parts of a video presentation are called and displayed (column 13, line 59-column 14, line 25 of Brandt). Brandt does not disclose that images and program to use them is stored on a removable storage medium. However it would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of Brandt with the use of a removable storage medium because it was well known that the use of a removable storage medium with a program allowed for greater portability.

Regarding dependent claim 3, Brandt discloses a method in which the video presentation is downloading into the storage medium and the thumbnails corresponding to slides are also downloaded into the storage medium to be used to view the parts of the presentation (column 14, lines 13-37 of Brandt).

Regarding dependent claim 4, Brandt discloses a method in which thumbnail images are displayed and based on the selection of those images parts of a video presentation are called and displayed (column 13, line 59-column 14, line 25 of Brandt).

Regarding dependent claims 5 and 6, Brandt discloses a metho in which animation in the form of video information is stored and used by the system (column 13, line 59-column 14, line 25 of Brandt).

Regarding dependent claims 7 and 8, Brandt discloses a method in which the video presentation is viewed by connected to a network server, which stores the presentation (column 13, line 59-column 14, line 25 of Brandt). Brandt does disclose that network registration is used to make this connection. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Brandt's method with the use of network registration because using network registration was a well known method of information security to protect and distribute information only to authorized user's via a network server.

Regarding independent claim 9 and dependent claims 10-12, the claims incorporate substantially similar subject matter as claims 1-4. Thus, the claims are rejected along the same rationale as claims 1-4.

Regarding independent claim 13 and dependent claims 14-16, the claims incorporate substantially similar subject matter as claims 1-4. Thus, the claims are rejected along the same rationale as claims 1-4.

Regarding dependent claim 17, Brandt does not disclose that the storage medium has a read-only area and a writable area. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a storage medium with a read-only and writable area because it would have allowed for protection of the program itself while also allowing room for user data to be stored, which was a well-known practice in the art.

Regarding dependent claim 19, Brandt discloses the use of an optical disk as a storage medium (column 19, lines 15-30 of Brandt).

11. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brandt et al. (hereinafter Brandt, US Patent Number 6,646,655, filed on March 9, 1999) as applied to claim 13 above, and further in view of Microsoft Press (Microsoft Press Computer Dictionary, published in 1997).

Regarding dependent claim 18, Brandt does not disclose the use of a bootstrap program, which is used to load a system program to control the application. However, as defined by Microsoft Press a bootstrap loader program is a program that is run by a computer being booted up that tests the system and then passes control to a larger loader program (page 60, Microsoft Press). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Brandt with the use of a bootstrap program because it would have allowed for system tests to be run insuring proper loading before running Brandt's application.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US Patent Number 6,301,586

US Patent Number 6,400,853

US Patent Number 6,647,128

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D Campbell whose telephone number is (703)305-5764. The examiner can normally be reached on M-F (8:00 AM - 4:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (703)308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JDC
May 3, 2004

SANJIV SHAH
PRIMARY EXAMINER